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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/007,781	11/13/2001	Stacey Bolk	2825.2025-001	1826
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28120 7590 05/24/2004

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 BOSTON, MA 02110-2624

EXAMINER
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SITTON, JEHANNE SOUAYA

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action**

Application No.

10/007,781

Applicant(s)

BOLK ET AL.

Examiner

Jehanne Souaya Sitton

Art Unit

1634

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 20, 26 and 28.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 10, 21-25, 27, and 29-38.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

*Attachment*

1. The amendment filed May 10, 2004 will not be entered because the proposed claim amendments in claims 21, 29 and 35 require further search and consideration under 35 USC 112/first paragraph, 35 USC 112/2<sup>nd</sup> paragraph, 35 USC 102 and 35 USC 103. Additionally, the proposed amendments to claims 21 and 35 would require a new ground of rejection under 35 USC 112/2<sup>nd</sup> para because it is unclear if the amendment requires that the allele specific oligonucleotide need only be capable of hybridization to position 3949 of SEQ ID NO: 1, or does hybridization also include nucleotides on either side of it. Additionally, the recitation of “stringent conditions” would require new grounds of rejection under 35 USC 112/first paragraph. Applicant’s arguments as they pertain to the pending claims will be addressed.

2. The response traverses the rejection under 35 USC 112/1<sup>st</sup> paragraph, Written Description, with regard to claim 19 and asserts at page 6, that the claimed recitation of “a nucleotide other than thymidine” was clearly envisioned because it only encompasses a C, A or G at that position. This argument has been thoroughly reviewed but was not found persuasive. The specification does not teach that either the C or the A allele occur in nature. While it is true that one could construct variants with an A or a C at position 3949, the specification has not set forth what affect such a polymorphism would have with regard to either thrombospondin activity or disease association. Accordingly, the rejection is maintained. Arguments with regard to claims 21, 35, and 29 will not be addressed, as they do not pertain to the instantly pending claims.

3. The proposed amendment to claim 29 would overcome the rejection made under 35 USC 112/2<sup>nd</sup> paragraph made in the previous office action.

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4. The arguments with regard to 102(b) rejections over claims 21-24 as anticipated by Kasuno, 29-34 as anticipated by Genbank Accession number AF109906, and 29-30 as anticipated by Brennan, and the rejection made under 35 USC 103(a) over claims 35-38 will not be addressed as they do not pertain to the instantly pending claims.

5. The arguments traversing the rejections under 35 USC 102 with regard to Fodor will be addressed to the extent that they apply to the instant pending claims. The response traverses that Fodor only provides a general teaching of an infinite number of 10mer containing any sequence. This argument was thoroughly but was found unpersuasive as the number of possible 10mers is not a set composed of infinite sequences, but represents a finite set of sequences. Such sequences can be readily envisioned, although it would require some time and a large amount of paper to list all the members of the set. The recitation of Fodor is not considered analogous to a compound which is not specifically named because in this case Fodor actually possesses an array comprised of every possible 10 mer nucleic acid sequence. They exist, and are isolated and located on the array taught by Fodor and therefore anticipate the list of possible 10 mer nucleic acids encompassed by the claims. The fact that it is impractical to list each sequence due to the amount of space it would take to do so, does not take away from the fact that such sequences were constructed and exist. Applicant's citations with regard to *In re Baird* and *In re Belle* are not persuasive as such case law are misapplied with regard to the previous office action as the claims were rejected under 35 USC 102 and not 35 USC 103. With regard to *In re Baird*, here there is no need for motivation to make 3 specific compounds, because they were already made. Further, with regard to *In re Belle* there is no need for motivation as to why one would seek the claimed compound as again, these sequences were already constructed. Applicant's citation of

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*Structural Rubber Products Co. v Park Rubber Co* was not found persuasive because it does not detract from the fact that Fodor teaches the claimed nucleic acids, although he does not list each one they can be readily envisioned and the disclosure of the array does not represent an infinite list of sequences. Further, with regard to the traversal over the disclosure of Brennan, it is noted that Brennan actually lists each 3mer sequence. Therefore, for the reasons set forth with regard to Fodor, the rejections are maintained over the instantly pending claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (571) 272-0507.



Jehanne Sitton  
Primary Examiner  
Art Unit 1634

5/21/04